REMARKS

In Response to the Examiner's Office Action of September 23, 2004, Applicant is presenting the following statements for consideration.

With respect to the Examiner's objection to the amendment filed May 26, 2004, on the subject of "new matter", it will be seen that Applicant has withdrawn certain of the changes made in the prior amendment and reinstated the original statements involved.

(a) At page 30, line 34 of the specification, Applicant has reinstated the phrase "one-dimensional array" and removed the statement regarding "single two-dimensional array".

(b) In Figs. 7C and 7D, Applicant has reinstated the phrase "use one-dimensional array", as was originally stated. Replacement sheets are provided for Figs. 7C and 7D to indicate the original drawings that were presented in this case.

(c) In regard to Applicant's original specification at page 6, lines 5 and 19-20, Applicant has reinstated the original specification which states:

> A selection is made as to the use of a single dimensional array or a dual two-dimensional array for buffer loading. ----

Thus, it will be noted that Applicant has cancelled any of the cited new matter, which the Examiner has objected to.

In regard to better understanding Applicant's specification and the improvements provided by the inventor, Applicant wishes to indicate that:

(i) The first and early version of the DFAST program used for downloading SCSI firmware, only involved the use of a single one-dimensional buffer array.

(ii) Then, due to the larger and generally more enormous sizes of the firmware download sets, it was found that this original DFAST program was inadequate and incapable of handling the heavy downloads in any efficient manner. As a result, the inventor of this application was assigned to upgrade the DFAST program in order to make it more efficiently compatible for handling the newly huge and enormous sizes of SCSI firmware downloads.

(iii) As a result, the inventor of this application was assigned, and devoted himself to developing and improving the original DFAST program in order to develop an UPGRADED DFAST program on which the inventor worked from 1996 through 1999 before such a program was fully developed and tested, and which became the subject of this patent application.

(iv) The previous documents that were presented as an Appendix to the Examiner, and which were marked "1994" were found to be *inadvertently* and *mistakenly* marked with a "1994" copyright, when it should have been a "1999" copyright.

(v) Attached herein will be found a series of exhibits which indicate the inventors' work from 1996-1999 and

also a copy of the upgraded DFAST program which is the subject of this application and which was held confidentially and internally within the Unisys Corporation. Thus, as of the first quarter of the year 1999, there could not possibly have been any leakage or possible knowledge or possible public use of this program, which also, by the way, was completely held confidential and within the confines of the Unisys engineering facility. Exhibits E-7, E-8, E-9 will show documentation validating a 1999 Copyright date.

On the subject of "admitted" prior art which Examiner has indicated to be found in Applicant's Remarks on page 29, it should be indicated that these particular statements were inappropriately phrased, as actually the well-known portion of prior art involves that it is well-known that decision points can be made. However, in Applicant's system, the decision point involved a new situation in 1999 where a choice could be made between a single one-dimensional array, or a dual two-dimensional array.

Thus, the language used was inappropriate, in that it was only intended to indicate a decision point which could choose one or another branch of operations, but it did not intend to indicate the use of single one-dimensional arrays and dual two-dimensional arrays, as was done in the upgraded version of the DFAST program of 1999.

In regard to clarification of Applicant's misguidedly worded statements, Applicant would now ask that the Examiner withdraw his rejection of claims 1, 4, 12, and 14 under 35 USC Article 112, first paragraph.

The Examiner has stated that Applicant's Appendix I in the Amendment of May 26, 2003, suggests that the claimed invention was reduced to practice and embodied in a product or service available to the public more than one year prior to the filing date of the instant application.

(a) In this regard, Applicant is providing exhibits which show that the upgraded DFAST program, which was filed on September 10, 1999, was actually worked on by the inventor from 1996 through 1999 in order to solve the inadequacies of the first and original DFAST program, and additionally, this material was kept confidential and within the confines of the Unisys Corporation engineering group.

(b) Also, it might be indicated that the original DFAST program of 1994 was kept confidential and within the confines of the Unisys engineering group, and used for testing and debug purposes only when a customer required assistance from the Unisys engineering group.

In regard to Examiner's request for information under 37 CFR Article 1.105, Applicant would indicate that any products or services that may have incorporated the claimed subject matter had a Class C designation which restricted disclosure only to in-house Unisys personnel.

This would involve internal testing and debugging done by engineering support personnel which might have been requested by customers of the Unisys Corporation, and which would be done only by in-house Unisys engineering personnel and no

information regarding the DFAST program could be or was given to any outside parties.

Further, it should be noted that the "original" DFAST program of 1994, which involved the use of a single one-dimensional array, and which was found to have many problems in handling large enormous firmware coded sets, that a upgrading program was instituted from 1996 to 1999 by the present inventor in order to overcome the deficiencies of the original program thus, to develop the upgraded DFAST program, which is the subject of this patent application.

Thus, it can be understood that there was no way that this upgraded DFAST program could have been used in any sense whatsoever outside of the internal development work done by the inventor within the Unisys Corporation. Therefore, there could not be any possibility of any public use of the upgraded DFAST program during the period of one year before the filing of the patent application on September 10, 1999.

In regard to the drawings of Figs. 1A, 1B, 1C, 1D, 2, 3, 4 and 5, they have now been designated with a legend of "prior art", as requested.

In regard to Fig. 6 which illustrates a two-dimensional array, the Examiner has indicated certain typographical errors, such that the nTH column of the array should be labeled "8191" instead of "8192". This has now been accomplished.

Further, in the original drawings of Fig. 6 in the descriptive label of Array Buffer [0:47,0:8192] in Fig. 6, has been changed to indicate the bracket as [0:47,0:8191].

Likewise, the upper left-hand corner in Fig. 7C will indicate the reference connector as "I".

The Examiner has indicated objections to claims 16 and 17 for indefiniteness for failing to point-out and distinctly claim the subject matter. In this regard, Applicant has now amended both claims 16 and 17 to eliminate the "YES" and the "NO" statements and to further refine the meaning of the branch points which are involved in these claims. Thus, these claims 16 and 17 should present a clear view of the steps involved as they were derived from the drawings of Figs. 7B and 7C.

Examiner has indicated that claims 1, 4, 8, 12, 14, 16, and 17 have been rejected under 35 USC 102(b) based upon a public use or sale of the invention.

In regard to this allegation, Applicant has provided a series of exhibits which indicates that the subject of this invention involved the upgraded DFAST program which was developed and tested from 1996 to 1999 by the inventor, and which was filed on September 10, 1999, within the one-year limitation of the completion of the invention, which involved the use of both single and dual two-dimensional arrays. See Exhibits E-7, E-8, E-9.

It should be indicated that the statement regarding the DFAST coding that Applicant mentioned (in the last Amendment of May 2004), was an inaccurate statement in regard to the program which was shown in Appendix I, because of the inadvertent

application by the engineering group of the "1994 copyright statement" which should have been a copyright statement indicating a copyright of 1999.

Applicant has also attached an exhibit under Appendix III, which exhibit is the entire "upgraded" DFAST program (which was inadvertently marked "Copyright 1994" instead of "1999") and in this document, it will be seen that there are certain areas indicated which have been patched into the original single one-dimensional DFAST program in order to apply it to utilize the single or dual two-dimensional buffer array operations. This can be noted by observing that the narrow width coded indicators on the right-hand side of each sheet indicate the original DFAST operations, while the long extended width coded indications will show the added and upgraded DFAST program operations which show the 1999 upgrade.

> Thus, by observing each page, one can see exactly where the additive upgrade programming was inserted to develop the upgraded DFAST program thus, enhancing the deficiencies of the original coding which is shown by the narrow width coded indicators.

Again, to reiterate regarding the question of public use, Applicant would emphasize that the upgraded DFAST program used in Applicant's invention was not fully completed until the first quarter of 1999 and thus, there could not have been any possible public use of such of the upgraded DFAST program, as the patent application involved here before one year after the completion of the upgraded DFAST program.

The Examiner will find attachments of various exhibits which are designated to show Applicant's development of the

upgraded DFAST program during the years of 1996 through 1999, and also, a copy of the completed and upgraded DFAST coding which indicates the additions and upgrades which were added to the original DFAST program (which was limited to use of a mere single one-dimensional array).

In view of these factors and exhibits which have been presented and indicated by the Applicant, it is respectfully requested that the Examiner re-evaluate his previous considerations and objections, and understand that the upgraded DFAST program was developed and tested by the inventor and completed during the period of 1996 to 1999, and for which there could not have been any possible public use one year before the filing of the application on September 10, 1999.

And likewise, with the amendments to the claims, and with the understanding that the previous Appendix I in the May 2004 Amendment, had a mistaken cover sheet (which indicated copyright 1994) which should have been shown as copyright 1999 to properly reflect the time period in which the invention was completed --- so, in this regard, Applicant would now pray that

Examiner will re-evaluate his previous assumptions and objections, and now properly consider that the claims are worthy of a Notice of Allowance.

Respectfully submitted,

By Alfred W. Kozak

Alfred W. Kozak
Reg. No. 24,265
(858) 451-4615
(949) 380-5822

Certificate of Mailing (37 CFR 1.8a)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: MAIL STOP AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Patti S. Preddy

Date: December 15, 2004 Patti S Preddy

APPENDIX I

DECEMBER 15, 2004 AMENDMENT
USSN 09/394,023

The following notations should be emphasized:

(a) The original DFAST program for downloading SCSI firmware merely used facility of a single one-dimensional buffer array which led to delays and problems for efficiently downloading large, enormous size firmware code sets.

(b) The "upgraded DFAST program" added the capability of single or dual two-dimensional buffer arrays which enabled a faster and more efficient method for downloading the ever-increasing sizes of SCSI firmware which were appearing on the scene.

(c) In Applicant's May 24, 2004 Amendment on page 8, at the next-to-last paragraph, Applicant stated the use of the 1994 DFAST software patch. However, it should be clarified and cleared that the date of 1994 was incorrect and inappropriate and should have shown a copyright date of 1999. However, the use of "branch points" was already well-known for usage in the software arts.

Additionally, at page 28 of Applicant's prior Amendment (the last paragraph) again, the Applicant mis-spoke by indicating the DFAST program in 1994, as using the selection of first and first and second buffer arrays --- since now this date should

have indicated that this occurred as of 1999 with the upgraded DFAST program which was being developed from 1996 through 1999.

The improper and inaccurate placement of the 1994 copyright on the upgraded program (which was developed from 1996 to 1999) led to several misleading comments and statements which should now be deemed as inaccurate. With the discovery of the inaccurate copyright statement date, Applicant would now seek to correct any misleading comments which were provided in the Amendment of May 26, 2004.

APPENDIX II

STATEMENT BY INVENTOR
ON AMENDMENT FOR DOCKET 468-L
USSN 09/394,023

1. In connection with patent application USSN 09/394,023 filed September 10, 1999, entitled "Method For Efficiently Downloading SCSI and servo firmware to SCSI Target Controllers", I, Belisario Alanis, was the principal engineer in developing the program for accomplishing the tasks and solving the problems involved for downloading firmware used in the Unisys Corporation computer system networks.

2. The original DFAST program was developed in 1994 for downloading SCSI software, but was found to have many limitations and problems since it only used a single one-dimensional array and involved a single Write command required to accomplish the download. It soon became obvious in 1995/1996 that with the large size of firmware coding that was becoming necessary for usage, that the original system could not efficiently handle the proper downloading of these large-size firmware code sets.

3. Thus, in the years 1996 to 1999, I was assigned to develop and analyze a new upgraded program which would solve the problems involved in the old 1994 DFAST system.

4. As will be noted in the various exhibits attached, I spent several years of effort which led to the development and usage of multiple dual two-dimensional arrays which could be loaded via multiple download subcommands which were continued in repetitive operation by a single continuation command in the Master Control Program and which could efficiently handle the large-size firmware

coding sets which were becoming prevalent and needful for usage.

5. It was not until early in the year of 1999 that a finally tested and workable version of this download program was finalized and shortly after this, efforts were made to record and develop a patent application covering this upgraded program which then resulted in the subject patent application filed on September 10, 1999.

6. Thus, while the original version of the download program in 1994 was usable, it still presented so many problems and difficulties that the new upgraded program which used the single and dual two-dimensional arrays was developed, which solved the problems that had been occurring. Thus, the patent application USSN 09/394,023 reflected the factors that a single one-dimensional array could be used for small size firmware downloads, but when larger downloads occurred, there could then be used a single dimensional or the dual two-dimensional arrays which, with multiple commands, can be used to handle the download of huge large-sized firmware sets by sending small 8192 byte chunks repeatedly with offset pointers until the entire code set was downloaded.

7. As will be illustrated in another exhibit, the engineering group involved in the original DFAST program in 1994 inadvertently used the same cover sheet showing the 1994 copyright and placed this not only on the original single-dimensional array usage, but also inadvertently and improperly placed the 1994 copyright on my upgraded development work which was completed in 1999, and which is the subject of this patent application.

8. It should be understood that the original document supplied with the last amendment of May 26, 2004, showed the coding for the entire upgraded SCSI download system which had only been fully completed in early 1999 -- but the inadvertent use of the old cover sheet for a copyright was inadvertently and improperly placed upon the upgraded program system of 1999.

9. As a result of these various factors involving this situation, it should be understood that there could not have been any usage of my described invention which uses both single and dual two-dimensional arrays up to the first quarter of 1999, and the patent application was filed in less than one year after the completion date of my upgraded program.

10. It is now respectfully requested that the Examiner recognize the previously supplied DFAST program document (with a 1994 copyright) as being inapplicable to the situation, since the 1994 copyright cover sheet was inadvertently placed upon the updated improved program of 1999.

11. Since I was the principal engineer and developer of this upgraded project for SCSI downloading, and since I have also supplied various exhibits hereto indicated my participation in the later years of 1996-1998, and with my personal work in 1999, it should be emphasized that there was no way that any public use could be made of the inventive steps of the software involved.

12. In another document attached hereto, it will be indicated that also even the first original single one-dimensional DFAST program was kept in strict confidence and

used only in-house by Unisys engineering personnel. There was no public use, sale, or export of any of such information and documents.

13. I affirm the above statements to be true as of the best of my own personal knowledge.

Date: 11/18/04 Belisario W. Alanis

Belisario Alanis

APPENDIX III

LIST OF EXHIBITS
FOR USSN 09/394,023
(DOCKET 468-L)

E-1: Preliminary Specification Layout for new program development to upgrade DFAST program dated April 12, 1996.

At page 2 -- indicates disclosure only within Unisys Corporation with need to know.

E-2: Memo of September 13, 1996, to Inventor B. Alanis re DFAST UPGRADE.

E-3: Memo of November 19, 1996 to Inventor B. Alanis re DFAST UPGRADE.

E-4: List of 1996-1997 Test Runs by Inventor B. Alanis during development of UPGRADED DFAST.

E-5: Header Development work notes by Inventor B. Alanis on developing upgrade to DFAST.

E-6: DFAST UPGRADE work for Debug and Test in February 1997, by Bel Alanis.

E-7: Photo of Tape Volume of final upgraded DFAST program showing final level 1.005 DFAST, dated 7/14/99 and COPYRIGHT 1999.

E-8: **Engineering Information Release dated 7/7/99, for DFAST Level 01.005.**

E-9: **Copy of Final Coding Document for DFAST Version 01.005. It should be noted that the Copyright date was inaccurately shown as "1994" when it should have shown a Copyright of "1999" (as indicated in E-7 and E-8).**

Note on E-9: The interior columns of coding are shown as: (a) narrow width codes; and (b) wide width codes. The "wide" width codes indicate the upgrades to the earlier DFAST program.

IN THE DRAWINGS:

Please find attached Figs. 1A, 1B, 1C, 1D, 2, 3, 4, and 5, which have now been designated with a legend "Prior Art".

Please find attached Fig. 6 which has been corrected to indicate the columns of the arrays as "8191" instead of "8192". This also applies to the array buffer which now indicates "8191".

The priorly amended Figs. 7C and 7D sent with the Amendment of May 26, 2004, have now been withdrawn and have been replaced with the original Figs. 7C and 7D.